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| 10/812,070 | 03/30/2004 | Takayuki Yamaguchi | 119307 | 1308 |
| 25944 7590 03/16/2009 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850 | | | EXAMINER KEMMERLE III, RUSSELL J | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/812,070

Applicant(s)

YAMAGUCHI ET AL.

Examiner

RUSSELL J. KEMMERLE III

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 11-16, 24, 25 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 17-23 and 26-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/888)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

Based on the amendments made to claims 10, 23 and 31 which make them dependent from previously examined claims and therefore now containing all limitations of those claims the restriction of those claims is withdrawn. The claims are examined on their merits in this Office action.

Specification

Applicant has requested that the objection to the specification be withdrawn. However, the specification was never objected to. It was merely pointed out that due to the size of the specification it had not been checked in detail for all possible minor errors. Because of this and what appeared to be a direct translation of the specification the Applicant's assistance was requested in making sure that the specification was in proper idiomatic English and that any minor errors that are found are corrected.

Claim Rejections - 35 USC § 112

In view of Applicant's amendments to the claims and remarks the previous rejections under 35 USC §112 are withdrawn. Specifically with regard to claim 3 it appears that the heat distortion temperature is a property of resin materials which would be known to those skilled in the art.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-10, 17-23 and 26-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1, 17 and 26 have each been amended to recite that the resin molding is bent by "changing a position of the gripping portion to a position not along the constant extrusion direction". Support for this limitation was not found in the specification as originally filed, nor was it pointed out by the Applicant where such support could be found. A review of the specification as originally filed found only descriptions of the bending process being performed by "disposing the gripping portion at a position so as to orient in a direction crossing the constant extrusion direction" or similar wording. This is not found to support the amendment as it says nothing with respect to the position of the gripping portion being changed.

If support for this limitation is found in the specification as originally filed but was missed by the Examiner the Applicant is invented to point out where specifically in the specification as originally filed such support can be found.

Claim Rejections - 35 USC § 103

Claims 1-4, 6, 8, 9 and 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otagawa (US Patent 4,982,486) in view of Webster (US Patent 6,260,395).

Otagawa discloses a method of making a resin molding for use on vehicles. Otagawa discloses that the process involves extruding a resin body through known techniques (including the use of a sizer), followed by allowing the resin to at least partially harden, and performing an axial bend (Col 3 line 42 – Col 4 line 20).

Otagawa does not disclose that the axial bending is performed by gripping the resin molding in a bending apparatus and changing a position of the gripping portion to a position not along the constant extrusion direction.

Webster discloses a method of bending a workpiece where the workpiece is gripped in a bend die which is rotatably moved about a pivot axis causing the workpiece to bend (that is, the position of the bend die is changed to a position not along the extrusion direction) (Col 7 lines 18-33, compare Fig 2 with Fig 3, and Fig 6 with Fig 7).

Referring to claims 2 and 3, the molding would have to be bent while at an elevated temperature in order for the bending to result in a final piece having such a bend, as is known to those in the art. If this were done using residual heat from the molding process (that is, while it is cooling, as appears to be the case in Otagawa since it is not stated that the molding is cooled and reheated during the recited processing steps) this would result in the temperature inside being higher than the temperature on the surface (since the molding would cool from the outside inward).

Referring to claim 4, the bent molding of Otagawa has a radius of curvature that is different at different points of the molding (as shown in Fig 2).

Referring to claim 6, Otagawa discloses that after bending the body is water cooled during sizing (i.e., compulsory cooled) (Col 4 lines 50-55).

Referring to claim 8, Otagawa discloses that the molding be cut to length then bent. However, it would have been obvious to one of ordinary skill in the art that the selection of any order of these steps could have been effective, absent a showing of unexpected results. This would have been obvious because it appears that each step performs the same function in Otagawa and in the current invention, and that the performance of that step is not dependant on the other step being performed first. Specifically the bent body could be cut to size in the same manner that an uncut body could be, and a cut body could be bent in the same way as an uncut body. See *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) (selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results).

Referring to claim 9, while the specific action performed by the bender in Otagawa is not disclosed, it would have necessarily had to have performed at least two of the steps recited in claim 9 to achieve the product shown in Fig 2. This is because if at least two of these steps are not performed the piece depicted in the figure could not have been made having such a shape while maintaining the constant angle of the cross section as is shown.

Referring to claim 17, Otagawa discloses that a first body be formed (stainless steel web) followed by passing it through an extrusion die, the resulting body is then bent. However, it would have been obvious to one of ordinary skill in the art that the selection of any order of these steps could have been effective, absent a showing of unexpected results. This would have been obvious because it appears that each step performs the same function in Otagawa and in the current invention, and that the performance of that step is not dependent on the other step being performed first. Specifically the bent stainless steel sheet could be passed through the extrusion die to have a resin part formed on it in the same manner that an uncut sheet could be, and a stainless steel sheet with the resin already molded to it could be bent in the same way as a sheet without the resin molded on to it. See *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) (selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results).

Referring to claims 18-21, these limitations have been addressed above in the rejections of claims 4, 9, 8 and 6 respectively, and are reasserted here.

Referring to claim 22, Otagawa discloses that the first member be a stainless steel (metal) strip that has been roll-formed (Col 3 lines 42-44).

Claims 10 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otagawa in view of Webster as applied above to claims 1 and 17, and further in view of Uchimura (US Patent 6,739,599).

Otagawa and Webster are relied upon as discussed above, but does not disclose performing an axial twisting process on the resin molding.

Uchimura discloses a method of making a resin molding substantially similar to that of Otagawa, also for use as weather stripping on a vehicle. Uchimura further discloses that the molding be subjected to a twisting and flexing (bending) step in order to ensure a proper fit on the vehicle.

It would have been obvious to one of ordinary skill in the art, at the time of invention by Applicant, to have modified the teaching of Otagawa in view of Webster by also performing an axial twist on the molding to ensure that the molding fit properly on the vehicle.

Response to Arguments

Applicant's arguments filed 26 November 2008 have been fully considered but they are not persuasive.

Applicant first argues that Otagawa discloses that the moldings are cut into a predetermined length before they are bent that it fails to disclose the claimed continuous supplying of the molding to a bender.

It is first noted that a continuous supply does not require that the molding not be cut before being supplied to the bender. It merely requires that after the bending is performed on a molding that the next molding is promptly fed to the bender as would traditionally be done by one skilled in the art in order to maintain processing speeds at a high level.

Further, regarding the claims which do require the molding to be cut after the bending process (such as claim 8) the selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results when the performance of one processing step does not depend on the previous processing step already being performed. This is discussed in more detail above and in the previous Office action.

Applicant further argues that Otagawa fails to specifically teach the recited bending steps (changing a position of the gripping portion to a position not along the constant extrusion direction).

This limitation was not present in the previous claims, and is addressed above.

Conclusion

Applicant's amendment necessitated any new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RUSSELL J. KEMMERLE III whose telephone number is (571)272-6509. The examiner can normally be reached on Monday through Thursday, 7:00-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. J. K./
Examiner, Art Unit 1791

/Eric Hug/
Primary Examiner, Art Unit 1791